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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,940	01/14/2004	Martin Sting	F-653	3287

7590 07/13/2005

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Intellectual Property and Technology Law Dept.
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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,940

Applicant(s)

STING, MARTIN

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on April 22, 2005.

Specification

2. The amendment filed April 22, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "In one embodiment, envelop-separating arrangement 6 includes an envelope-flap-opening device."

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature "an envelope-flap-opening device is arranged upstream of the envelope-conveying device" in claim 7 (lines 1-3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al. (6,164,046) in view of Malick (5,180,154) and Belec et al. (5,447,015).

Werner discloses an apparatus comprising:

a feeding device 18 for horizontally feeding enclosure 20 to a push-in arrangement 28;

an envelope-separating arrangement (figure 4 shows the stack of envelopes 14 being separated to a sequence of envelopes);

an envelope-conveying device 12 conveying the envelopes 14 to the intermediate envelope-conveying device (figure 1 show the envelopes being conveyed from conveyor 12 to the intermediate envelope-conveying device upstream of the push-in arrangement);

an aligning means position the envelope upstream of the push-in arrangement (figure 1 shows the envelope being aligned before the push-in arrangement).

Werner discloses the claimed invention, but does not expressly disclose the intermediate envelope-conveying device having a direction running at an angle in the range of from 15-75 degrees to the conveying direction of the envelope-conveying device, filled envelope can be conveyed away from the envelope-filling station by an envelope-advancing device 58, 64, and the angled stop arrangement.

Malick discloses an apparatus comprising an intermediate envelope-conveying device 5 has a direction running at an angle in the range of from 15-75 degrees to the conveying direction of the envelope-conveying device (figure 1) providing a more effective means to conveying envelope at a higher speed of production. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Werner apparatus by incorporating the intermediate envelope-conveying device as taught by Malick to provide a better means to convey envelopes at a faster speed of production.

Belec discloses an apparatus comprising an angled stop arrangement 50 (figures 14-16); the envelope can be positioned by way of two abutting edges (fingers 52 of the angled stop arrangement can be moved back a small distance in relation to the push-in movement as shown in figures 17 and 12). Belec's apparatus provides reliability and speed for the insertion station. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Werner apparatus by incorporating the angled stop arrangement as taught by Belec to provide a simplified enveloped insertion mechanism that is reliable and fast.

Belec's angled stop arrangement positioned opposite the push-in arrangement, which can be switched to active position so that the envelope is fixedly positioned for receiving an enclosure from the push-in arrangement (Belec – figures 12-14). Once the envelope has been filled with the enclosure, the angled stop arrangement can then be switched to the inactive state such that the filled envelope can be conveyed away from the envelope filling station by an enveloped-advancing device (Belec – figures 15-16), and once it has been switched to the active state and before being switched to the inactive state, the angled stop arrangement can be moved into an intermediate stop position in which at least one angled stop part, against which the envelope edge which is perpendicular to the push-in direction of the push-in arrangement is positioned, is moved back, by a comparatively small distance in relation to the push-in movement, in the push-in direction (see figures 17 and then figure 12, figure 17 is the beginning of the cycle of the active state, and figure 12 is in the middle of the active state – figures 17

and 12 show a small distance movement of the device between active state and inactive state which begin in figure 15).

The modified reference of Werner apparatus further discloses: the push-in arrangement contains push-in fingers 28a-d which can be moved back and forth (figures 2A & 2B shown that fingers 28a-d can be moved in both direction of the pivot point); the push-in belts are provided with push-in fingers and circulate over the feeding device (figure 2A); the envelope-conveying device has abutment means which interact with the top strand of the conveying belts 12 and the envelope-advancing device has a conveying direction which runs transversely to the push-in direction of the push-in arrangement (figures 1 & 4);

the intermediate envelope-conveying device is controlled such that its conveying means are kept in operation even when the conveyed envelope has run up against the angled stop arrangement (Malick, column 4, lines 56-60); the angle of the conveying direction of the intermediate envelope-conveying device is in a range from 40-50 degrees (Malick, figure 1);

the angled stop part is formed by a stopping straightedge (fingers 52 contain straightedge) which can be switch over between two pivoting position and can be pivoted about a horizontal pivot axis running perpendicularly to the push-in direction of the push-in arrangement (Belec, figures 14-16); the drive of the angle stopping arrangement contains a rotary drive, a rotary magnet (Belec, column 4, lines 48-49); the pivot axis of the stopping straightedge is located beneath the level of the horizontal plane determined by an intermediate envelope-conveying table.

Belec discloses (figures 18 & 19) the perforated conveying belts 60 running over vacuum chamber, but it does not located at the intermediate envelope-conveying device. It is within the skill of one in the art to incorporate the vacuum conveyor belts as taught by Belec into Malick's intermediate envelope-conveying device providing more effective means to move envelopes on the conveyor. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Werner and Malick apparatus by incorporating the perforated conveying belts running over vacuum chambers as taught by Belec to provide a more effective means to convey envelopes.

6. Claims 7, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al. (6,164,046) in view of Malick (5,180,154) and Belec et al. (5,447,015) and further in view of Viens et al. (5,950,399).

As discussed above in paragraph 5, the modified Werner discloses the claimed invention, but does not expressly disclose the envelope-flap-opening device arranged upstream of the envelope-conveying device.

Viens discloses an apparatus comprising the envelope-flap-opening device (Viens, figures 2-4) arranged upstream of the envelope-conveying device (Viens, figure 1). Viens apparatus provides high speeds insertion device that is economically fabricated and more flexibility (Viens, column 1, lines 51-62). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Werner apparatus by incorporating the envelope-flap-opening

device as taught by Viens providing high speeds, flexible and economically fabricated envelope insertion device.

The modified reference of Werner (and Viens, figure 1) further discloses the envelope-conveying device contains endless, circulating conveying belts unit 18, which are arranged parallel to one another, abutment rollers 76 which each interact with the top strand of the conveying belts and butt against the top side of the envelope; and the axes of rotation of the abutment rollers are oriented orthogonal to the conveying direction.

7. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al. (6,164,046) in view of Malick (5,180,154) and Belec et al. (5,447,015) and further in view of Malick et al. (6,102,391).

As discussed above in paragraph 5, the modified reference of Werner discloses the claimed invention, but does not expressly disclose the spherical rolling bodies, which are guided in cages of a housing-mounted abutment rollers as recited in claims 9 and 12.

Malick (6,102,391) discloses (figure 6) a housing-mounted abutment means which include spherical rolling bodies which are guided in cages of a housing-mounted abutment rollers to provides positive contact between envelopes and conveying surface. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Werner apparatus by incorporating

the spherical rolling bodies as taught by Malick (6,102,391) providing a means to secure the conveying of the envelopes.

Response to Arguments

Applicant's arguments filed April 22, 2005 have been fully considered but they are not persuasive.

8. In response to the Applicant's amendment to overcome the objection of the drawing (regarding to claim 7), the objection of the drawing regarding to claim 7 has been repeated because of the new matter as stated in the paragraph 2 of this office action. The Applicant stated that the amendment, of the specification (page 4, line 18) was added to clarify that it is known in the art that the envelope-separating-arrangement 6 may include a flap opening device", however, the statement that "it is known in the art" is not in the amended specification.

9. In response to the Applicant's argument that the "stopping the envelope in the diagonal transport is not described or suggested by either of the Werner or Malick references, alone, or taken together.", the examiner maintains that Belec (not Werner or Malick) is relied upon for the angled stop arrangement positioned opposite the push-in arrangement which can be switched to active position so that the envelope is fixedly positioned for receiving an enclosure from the push-in arrangement (Belec – figures 12-14). Once the envelope has been filled with the enclosure, the angled stop arrangement can then be switched to the inactive state such that the filled envelope can

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be conveyed away from the envelope filling station by an enveloped-advancing device (Belec – figures 15-16), and once it has been switched to the active state and before being switched to the inactive state, the angled stop arrangement can be moved into an intermediate stop position in which at least one angled stop part, against which the envelope edge which is perpendicular to the push-in direction of the push-in arrangement is positioned, is moved back, by a comparatively small distance in relation to the push-in movement, in the push-in direction (see figures 17 and then figure 12, figure 17 is the beginning of the cycle of the active state, and figure 12 is in the middle of the active state – figures 17 and 12 show a small distance movement of the device between active state and inactive state which begin in figure 15) as recited in claim 1.

10. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures take as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, Belec's angled stop arrangement provide a device that is speedy and reliable and in combination Werner, Malick and Belec comprise a simplified enveloped insertion device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

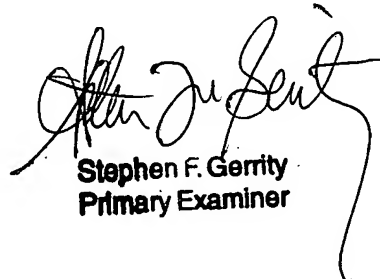
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

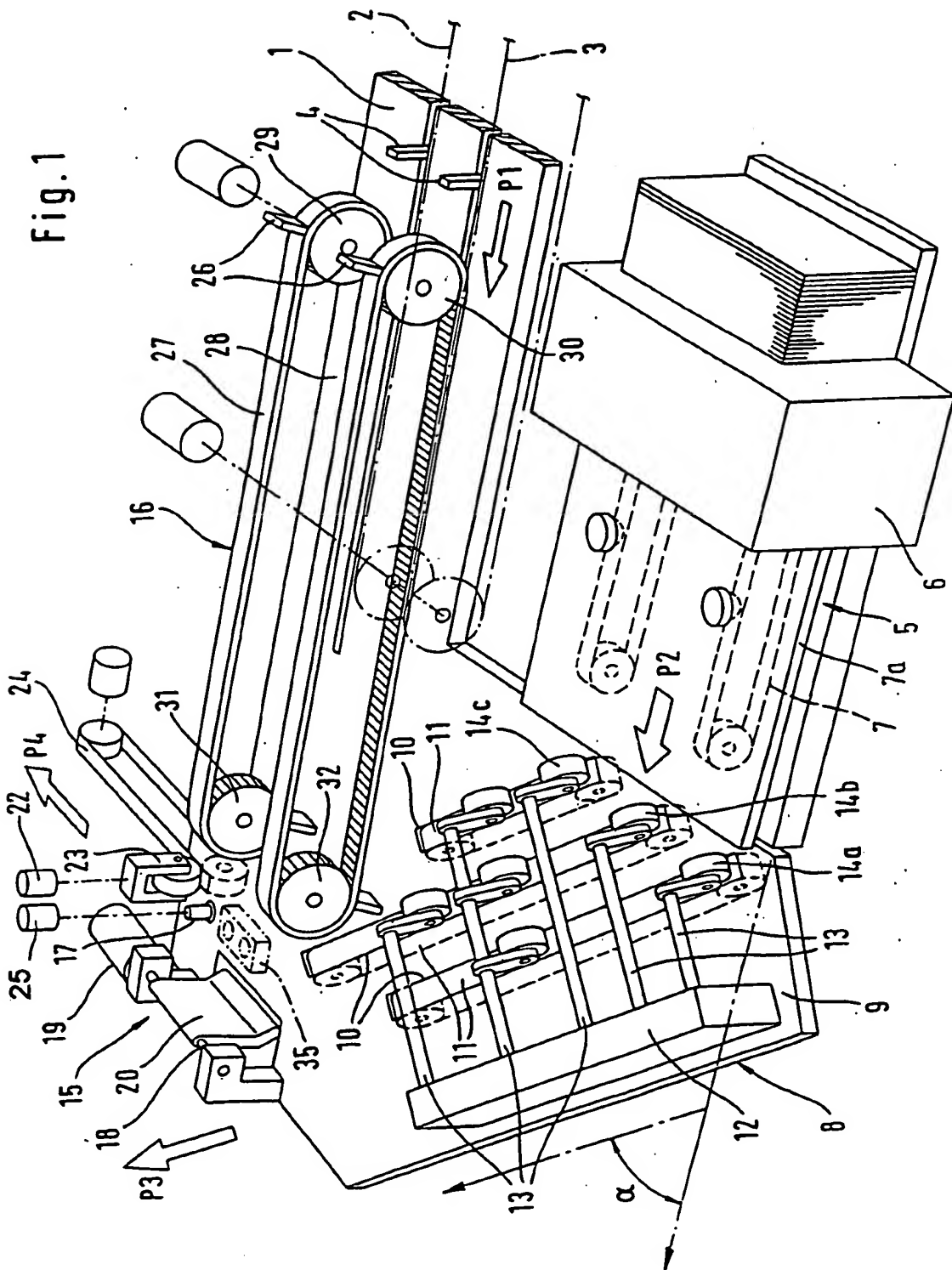
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Tkt
July 10, 2005.



Stephen F. Gerrity
Primary Examiner

Fig. 1



DRAWINGS APPROVED- the 7/10/05

REPLACEMENT SHEET

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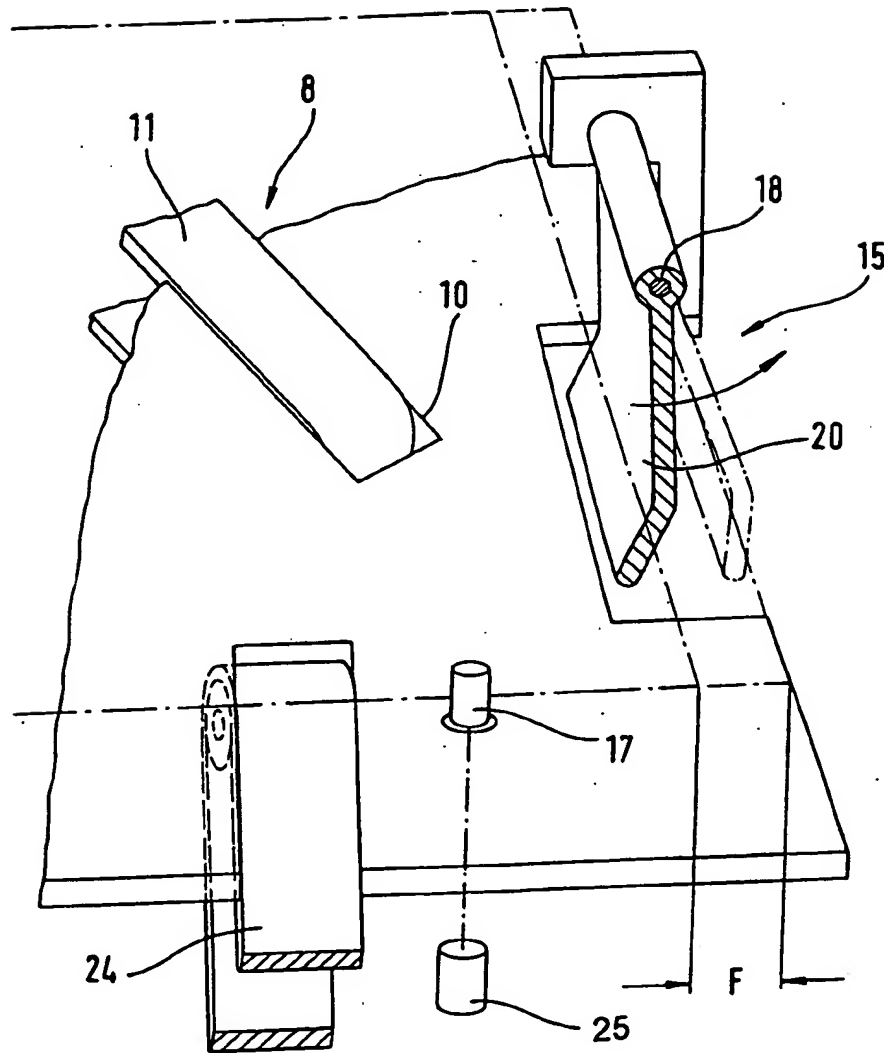


Fig. 3

REPLACEMENT SHEET

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